

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  920522-114515			
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number  10/583,580	Filed  December 08, 2008		
		First Named Inventor  Nidham Ben Rached			
		Art Unit  2617	Examiner  Chayce R. Bibbee		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p>  <p>This request is being filed with a notice of appeal.</p>  <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>  <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>26,935</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><u>/William M. Lee, Jr./</u> Signature</p><p><u>William M. Lee, Jr.</u> Typed or printed name</p><p><u>312-214-4800</u> Telephone number</p><p><u>June 20, 2011</u> Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>26,935</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/William M. Lee, Jr./</u> Signature</p> <p><u>William M. Lee, Jr.</u> Typed or printed name</p> <p><u>312-214-4800</u> Telephone number</p> <p><u>June 20, 2011</u> Date</p>
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<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In the application of** : Nidham Ben Rached  
**Serial No.** : 10/583,580  
**Filed** : December 8, 2008  
**For** : Position-finding Method in a  
Radiocommunication System  
**Examiner** : Chayce R. Bibbee  
**Art Unit** : 2617  
**Customer number** : 23644  
**Attorney Docket No.** : 920522-114515

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Honorable Director of Patents and Trademarks  
P O Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests pre-appeal brief review of the final rejection in the above-identified application of April 07, 2011. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and form PTO/SB/33.

In the final action, the Examiner rejects currently pending claims 17 to 34 under 35 U.S.C. § 102(e) as being anticipated by US patent publication US 2003/0040323 A1 (Pihl et al.). Details of the Examiner's analysis/reasoning are summarized below with respect to the independent claims 17, 23, 29 and 32.

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Office Action asserts that Phil et al. teaches

*“A method of determining a position of a mobile terminal, comprising:  
while a first base station that communicates wirelessly according to a first protocol has a connection over a wireless link with the mobile terminal, the first base station sending a location request to the mobile terminal, wherein the location request corresponds to a request made by a remote client and the location request specifies that the position of the mobile terminal is to be based on measurements made with respect to information from a second base station that communicates wirelessly according to a second protocol different from the first protocol; (See at least the abstract as well as paragraphs [0038]-[0040], where Pihl discloses an SMLC receiving a location request from an LCS client and then forwards the request to the target mobile station which then measures BCCH frequencies of the base stations identified by the SMLC, then if the measurements are not sufficient then the SMLC receives measurement info from another SMLC linked to other base stations).”*

The interpretation of the prior art by the Examiner is in error. Pihl discloses, at no location, the following feature of independent claims 17, 23, 29 and 32:

*“a second base station that communicates wirelessly according to a second protocol different from the first protocol”* with the mobile station.

The Examiner has clearly performed the analysis of the prior art with hindsight. Contrary to the statement of the Examiner, Pihl only discloses a wireless station that communicates with base stations that use the same communication protocol. Pihl's disclosure is essentially directed to the co-operation of two different providers in a border area to be able to provide location services.

He (Pihl) *“provides a method of locating a mobile station in a telecommunications network having at least two network operators each having a serving mobile location centre linking to a plurality of base stations. When neither network has sufficient BTS*

*topology for providing a sufficient accurate location of the mobile station, the measurement information of the base station can be shared between the network operators for location calculation.” (paragraph [0010]; emphasis added).*

In this passage Pihl clearly states that there is one network. One communication network, however, is only operating under one communication protocol no matter how many base stations are involved in the communication. Furthermore the fact that different operators operate the one network does not change the fact that the respective different base stations of the respective operators operate under the same communication protocol.

Pihl only discloses the application of his method to GSM systems or to UMTS systems as individual alternatives. Nowhere does Pihl disclose a combination of GSM and UMTS nodes, nor their interoperation. This is further proven by the fact that there are only claims directed to the separate embodiments regarding GSM or UMTS (see claim 11 and claim 16). Moreover, the specification of Pihl clearly states that fact as well at various locations. One of those is paragraph [0040], for example. This passage relates to Fig. 4. As clearly can be seen Fig. 4 only shows PLMN (1) and PLMN (2). Both networks show the same equipment. If there were an interoperation of GSM and UMTS, there would have to be a Node B or a radio network controller RNC as for instance depicted in Fig. 3 of the specification of the present application respectively identified by reference 32 or 34. At the above given location Pihl discloses:

*“The telecommunications network as illustrated in Fig. 4 has been described in conjunction with a GSM network where the method of locating a mobile station is based on E-OTD, and the involved SMLC conveys RRLP E-OTD assistance data message to the target mobile station over the RR layer. However, the same illustrated network can also be viewed as a UTRAN network, wherein the method of locating a mobile station is based on IPDL OTDOA, and the observed time difference assistance data message is conveyed over the RRC layer. While the communication between the two SMLCs in a GSM network goes over an Lp interface, the communication between the two SMLCs in*

*a UTRAN goes over a lur interface. The lur protocol supports SMLC-SMLC communications in UTRAN". (Para [0040]; emphasis added)*

This passage clearly shows that different networks are considered as alternatives, and GSM is disclosed as one alternative and UMTS as another alternative. Pihl emphasizes that in the above quote in that he explicitly discloses that "the same illustrated network can also be viewed as a UTRAN network."

This means UTRAN components like radio network controllers and node Bs cooperate instead of base transceiver stations and mobile switching centers of the GSM network.

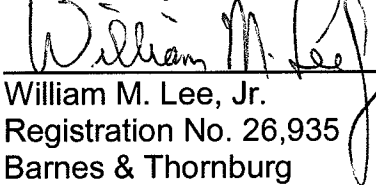
In view of the above, it is submitted that claims 17, 23, 29 and 32 are clearly not anticipated by Pihl, and are allowable. This also holds true for the dependent claims 18 to 22, 24 to 28, 30 and 33 to 34 at least by virtue of being dependent on an allowable independent claim.

## CONCLUSION

It is therefore submitted that the Examiner's rejections of the claims of this application are untenable as has been consistently argued by the applicant, and were this application to proceed to the Board of Appeals and Interferences, the rejections would be reversed. The results of this review are therefore awaited.

July 7, 2011

Respectfully submitted,

  
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